

## REMARKS

Claims 1-14, 16-18, 20-21, 23-46 and are pending. Entry of the amendment is respectfully requested. No new matter has been added. Reconsideration is respectfully requested. Claims 45-46 have been filed to replace canceled claims 19 and 22.

Reconsideration and withdrawal of the restriction requirement are respectfully requested. As shown in more detail herein, the restriction requirement is without legal basis.

### Applicants Provisionally Elect With Traverse

In response to the Office Action dated September 3, 2008 requiring restriction election, Applicants provisionally elect with traverse Group I. As discussed in more detail later, Group I is now directed to at least claims 1-14, 16-18, 20-21, 23-36, and 45-46.

Applicants acknowledge the Office's admission that elected Group I is classified in class 235/379. Claims 45 and 46 are even more specifically directed to class 235/379 subject matter. The Office's web site indicates that Art Unit 2876 is assigned and uniquely qualified to handle class 235/379 subject matter. Thus, Applicants request that this application be properly transferred to Art Unit 2876.

It is well established that the provided classifications of alleged Groups are critical factors for an Applicant in determining which Group to elect in response to a restriction requirement. USPTO rules dictate that an invention (i.e., claimed subject matter) is to be examined by the Art Unit which is most qualified and trained to examine the elected subject matter. Thus, Applicants' provisional election is *based* on the understanding that the Examiner will follow proper examining procedures by transferring this application to Art Unit 2876, which will result in the Group I claims being examined by an Examiner in Art Unit 2876 (which is not the current Examiner). Failure by the Office to provide such proper examination (via application transfer to

Art Unit 2876) will be a direct admission of impropriety. Also, if for some unexplainable reason this application is not accordingly transferred, then Applicants are entitled to new election.

**The Restriction Requirement is not legally proper because it is not timely**

Applicants respectfully submit that there are time limits as to when a restriction requirement can be made. MPEP § 811 indicates that an examiner is to “make a proper requirement as early as possible in the prosecution, in the first action if possible.” 37 C.F.R. § 1.142 indicates that the requirement is to “be made before any action on the merits.” Applicants respectfully submit that the restriction requirement is not in compliance with the statutes, rules, and Office procedures. The time for requiring restriction has long expired. The record shows that this application has already received numerous Office actions on the merits.

37 C.F.R. § 1.142 also indicates that a restriction requirement must be made “*before* final action.” However, this application has already received a Board decision. This decision was clearly *after* “final action.” Again, the restriction requirement is legally improper because it is not in compliance with the statutes, rules, and the Office’s own examining procedures.

As the record shows, that this application has already received numerous actions on the merits, including a Board decision. Yet the Office now suddenly *first* alleges that there is a need for a restriction requirement. This *first* allegation of a need for restriction appears to be an effort to deny Applicants judicial review of the refusal to grant their application. If true, this constitutes an abuse of agency authority. Such actions violate the Administrative Procedures Act, 5 U.S.C. § 701 *et seq.* Such agency action also violates the fundamental legal principle that an administrative agency may not avoid review of its actions by engaging in repetitive activity which does not remain in place long enough to enable judicial review. *Southern Pacific Terminal Co. v. Interstate Commerce Com.*, 219 U.S. 498, 55 L.Ed. 310, 31 S. Cr. 279 (1911).

**The Restriction Requirement is not legally proper because there is no serious burden**

MPEP § 803 sets forth criteria for a proper election requirement. One of the criteria is that there must be a serious burden on the Examiner in order for election to be required. Conversely, if the search and examination of an entire application can be made without serious burden on an Examiner, then it must be examined on the merits (which has already occurred). Because the application has already received numerous complete actions on the merits, the criteria for establishing serious burden has not been met.

The fact that numerous examinations on the merits have already occurred is *prima facie* evidence that there is no serious burden. The lengthy prosecution history evidence is in direct conflict with the sudden allegation of serious burden. How can the Examiner allege that the burden to examine the application is too hard when the application has already easily received numerous complete actions on the merits? Applicants respectfully submit that the requirement is also not legally proper because the criteria for serious burden has not been met.

**The Office has not shown the alleged Groups to be unrelated**

The restriction requirement is based solely on the allegation that the Groups are unrelated. However, inventions are unrelated if it can be shown that each: (1) they are not disclosed as capable of use together; (2) they have different designs; (3) they have different modes of operation; and (4) they have different effects (MPEP § 802.01 and MPEP § 806.06). The Office has not met the criteria for each of (1)-(4). Thus, the Office has not provided the required showing that the alleged inventions (Groups I, II, III, and IV) are unrelated.

The Office has not shown that the alleged inventions are not *disclosed* as capable of use together. Note Applicants' disclosure. What features prevent the Groups from being part of the

same system? For example, how are the alleged inventions not each capable of use with an automated financial transaction apparatus, especially when each Group refers to such automated financial transaction apparatus?

Applicants have presented *prima facie* reasoning (based on ordinary skill in the automated financial transaction art) that the alleged inventions are capable of use together (i.e., are related). The Office has not reasonably shown that the alleged Groups are unrelated, as is required to sustain the restriction requirement. As the restriction requirement is without legal basis, it should be withdrawn.

The Office's reasoning that the alleged inventions are unrelated because they have different scopes is without merit. Nor is it part of the legal criteria for insisting upon restriction. Related claims of varying scope are permitted. With the Office's reasoning, every single claim would constitute an unrelated invention. At best, the Office confuses unrelated inventions with mere differences in claim scope. Therefore, the restriction requirement is further legally improper.

### **Groups I and II**

Claims 2-14, 16-18, 20-21, 23-31, and 45 depend from claim 1. Thus, Applicants respectfully submit that elected Group I includes claims 1-14, 16-18, 20-21, 23-31, and 45.

Claim 32 has been amended to further show that claim 1 (of Group I) and claim 32 (of Group II) are neither independent nor distinct. Claims 33-36 and 46 depend from claim 32. Group II should be combined with Group I. Thus, Applicants respectfully submit that elected Group I also includes claims 32-36 and 46.

As a result, Group I should include at least claims 1-14, 16-18, 20-21, 23-36, and 45-46.

### **Groups II and III**

The record shows that independent claim 37 and independent claim 38 were both fully examined on the merits in the Office Action dated January 17, 2008. These same claims were also reviewed by the Board. Applicants' Response (dated May 14, 2008) to the Office Action (of January 17, 2008) did not include any amendment to claim 37 or claim 38. So, how can the Office now legally allege that claim 37 suddenly belongs to a different invention (Group II) from claim 38 (Group III)? It can't. The prior Office Action (of January 17, 2008) itself provides *prima facie* evidence that the restriction requirement is without legal basis.

### **Groups III and IV**

Both independent claims 38 and 44 are directed to an automated financial transaction apparatus. One of ordinary skill in the art of automated financial transaction apparatuses would recognize that claims 38 and 44 are *not* unrelated. Thus, the Office's reason for insisting on restriction between claim 38 (Group III) and claim 44 (Group IV) is not legally valid. Again, the restriction requirement is without legal basis.

### **Groups I-IV**

Applicants have shown that: Group I is related to Group II; Group II is related to Group III; and Group III is related to Group IV. That is, Applicants have shown all of the alleged Groups to be related. Thus, the Office's reason for insisting on restriction is not a legally valid reason. It follows that the restriction requirement is legally improper.

### **Rejoinder**

The Action has not addressed the issue of rejoinder of claims (MPEP § 821.04). Thus, the Action is incomplete. Applicants respectfully submit that even if the claims were somehow

directed to unrelated inventions as alleged, they would still be entitled to rejoinder. Applicants reserve all rights to rejoinder.

### **The Restriction Requirement Is Without Legal Basis**

Applicants also respectfully wish to point out that the Action fails to state a legally sufficient basis for imposing the restriction requirement. The Action indicates that the restriction requirement is solely based on a showing of the alleged inventions being “independent” (i.e., not related). The statutory authority for the Patent Office to impose a requirement for restriction is found in 35 U.S.C. § 121. The statute expressly states that before the Patent Office may require restriction, the inventions must be both “independent” and “distinct.” The regulations that have been promulgated pursuant to this statute, 37 C.F.R. § 1.141 and 37 C.F.R. § 1.142, both expressly state that before a requirement for restriction may be imposed, the inventions claimed must be both independent and distinct.

In the Action, there are only unsupported assertions that the sets of claims are unrelated. There are no assertions that the sets of claims are “distinct”, as is required. This standard does not comply with the statutory requirements. Therefore, the standard used in the Action for seeking to impose a requirement for restriction is legally incorrect due to noncompliance with the clear wording of both the statute and the regulations promulgated thereunder. Thus, the statutory requirements have not been met and no requirement for restriction may be imposed.

### **Conclusion**

For all the foregoing reasons it is respectfully submitted that the Office has provided no valid basis for the restriction requirement. Applicants respectfully request that the restriction requirement be withdrawn. All rights to file divisional applications are reserved.

Applicants reserve all rights to submit additional arguments regarding the restriction requirement. As this Response includes a request for reconsideration of the restriction requirement, should the request be denied then Applicants are entitled to petition.

Applicants respectfully submit that this application is in condition for allowance. The undersigned is willing to discuss any aspect of the Application at the Office's convenience.

Respectfully submitted,



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